

## **REMARKS**

Claims 9, 15, and 24 are currently amended. Claims 9-32 are currently pending. Reconsideration of the application in view of the current claims is respectfully requested and further in view of the following Remarks.

### **I. EXAMINER INTERVIEW**

Applicant wishes to acknowledge with appreciation the courtesies extended by the Examiner during the Examiner Interview on May 22, 2007. The Examiner's comments were helpful to Applicant in preparing this Response.

### **II. DEFECTIVE OATH AND DECLARATION**

The Examiner objected to the oath and declaration. Applicant submits a new oath and declaration identifying the application by application number and filing date in compliance with 37 C.F.R. § 1.67(a). Accordingly, Applicant requests that the objection to the Oath and Declaration be withdrawn.

### **III. INFORMATION DISCLOSURE STATEMENT**

Applicant acknowledges, with appreciation, the Examiner's indication that the references submitted in the Information Disclosure Statement filed January 7, 2005 have been considered.

### **IV. OBJECTIONS TO THE ABSTRACT**

The Examiner objected to the abstract for not commencing on a separate sheet in accordance with 37 C.F.R. § 1.52(b)(4). The Examiner also noted additional objections as to the form of the Abstract. Applicant submits herewith an amendment to the Abstract in an effort to overcome the objection and requests that the objection be withdrawn.

### **V. DRAWING OBJECTIONS**

The Examiner objected to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(5) for not including reference sign(s). The drawings are also objected to for failing to comply with 37 C.F.R. § 1.84(p)(5) for not including reference sign(s). The drawings are further objected to for failing to comply with 37 C.F.R. § 1.84(p)(4) because of the reference characters. Applicant submits replacement drawing sheets to address this objection and requests that the objection be withdrawn.

**VI. OBJECTIONS TO THE SPECIFICATION**

The Examiner objected to the disclosure for having informalities related to the use of the trademark Microsoft, Excel, and MATLAB. Applicant amends specification to overcome this objection and requests that the objection be withdrawn.

**VII. CLAIM REJECTION UNDER 35 U.S.C. § 112**

The Examiner rejected claims 15 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that there is insufficient antecedent basis for certain limitations in claims 15 and 24. Applicant has amended the claims to correct the antecedent basis rejection. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

**VIII. CLAIM REJECTION UNDER 35 U.S.C. § 103(A)**

During patent examination the PTO bears the initial burden of supporting a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence in prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led from the relevant teachings of the applied references to arrive at the claimed invention. This can be shown by showing some teaching, suggestion, incentive or inference to combine the references or showing that there is a design need or market pressure to solve a problem and there are a finite number of identified or predictable solutions a person of ordinary skill in the art has good reason to pursue and that the known objects are within his or her technical grasp. Mere identification in the prior art of each element is insufficient to defeat patentability of the combined subject matter. Further, Applicant's explanation of how the invention works does not render obvious that which is otherwise unobvious. Finally, there must be a reasonable expectation of success and the references must teach or suggest all of the claim limitations.

**A. Claims 9 and 11-13 have been rejected under 35 U.S.C. § 103 over Vortruba in view of Beijani**

The Examiner rejected claims 9 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Vortruba '859 in view of Beijani '042. With respect to independent claim 9, the Examiner asserts that:

Vortruba '859 teaches a passive motion device (Figure 9) which comprises a horizontal platform base (Figure 9, element 29) and a horizontal passive motion platform (Figure 9, Element 6 & 25) composed of a horizontal static platform (Figure 9, Element 25) which is rigidly connected to the upper lateral surface of the platform base (Figure 9, Element 29) and a horizontal laterally moveable platform (Figure 9, Element 6) which is flexibly connected to the static platform (Figure 9, Element 25), in which the static platform (Figure 9, Element 25) is adjacent to the laterally moveable platform (Figure 9, Element 6), which together both form the passive motion platform (Figure 9, Element 6 & 25), in which the movement of the laterally moveable platform (Figure 9, Element 6) is driven by a motor (Figure 1, Element 9) attached to the platform base (Figure 9, Element 29) where movement of the laterally moveable platform (Figure 9, Element 6) is achieved by means of a control arm (Figure 9, Element 19) that operably connects to laterally moveable platform (Figure 9, Element 6) to the motor (Figure 1, Element 9). Vortruba '859 teaches an imaging device (Figure 16, Element 101)... Beijani '042 teaches a processing system which comprises a computer incorporating a means for real time digital sampling.

See Office Action dated February 12, 2007, pp. 7-8.

Applicant respectfully disagrees with the Examiner's characterization of Vortruba as allegedly rendering Applicant's claimed invention obvious. Nothing in Vortruba would lead a person of skill in the art to an apparatus for the measurement of skeletal joint motion which includes a means for real time digital sampling of images of the moving joints. However, in an effort to advance the application to issuance, Applicant has amended independent claim 9 to clarify that it is directed to continuously moving a joint and real time digital sampling of images of the continuously moving joint during a continuous movement of the joint. As discussed in the interview with the Examiner, Vortruba does not provide for continuous controlled joint motion with real time imaging. Accordingly, Applicant requests that the Examiner withdraw the rejection of claim 9 over Vortruba '859 in view of Beijani '042 under 35 U.S.C. § 103(a). Claims 11-13 depend directly or indirectly from claim 9 and include the limitations thereof. Accordingly, for the same reasons Applicant requests that the rejection of claims 11-13 be withdrawn as well.

**B. Claims 10 and 14-32 have been rejected under 35 U.S.C. § 103 over Votrubia in view of Beijani and further in view of Bell**

The Examiner rejected claims 10 and 14-32 under 35 U.S.C. § 103(a) as being unpatentable over Votrubia '859 in view of Beijani '042 and further in view of Bell '859. Claims 10 and 14-32 depend directly or indirectly from independent claim 9. As discussed above, claim 9 is not obvious over Votrubia '859 in view of Beijani '042. In view of the fact that claims 10 and 14-32 depend from an allowable claim, Applicants request that the rejection of claims 10 and 14-32 be withdrawn.

**C. Claims 21, 23, 30 and 32 have been rejected under 35 U.S.C. § 103 over Votrubia in view of Beijani, in view of Bell and further in view of McGregor**

The Examiner rejected claims 21, 23, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Votrubia '859 in view of Beijani '042, in view of Bell '859 and further in view of McGregor '060. Claims 21, 23, 30 and 32 depend directly or indirectly from independent claim 9. As discussed above, claim 9 is not obvious over Votrubia '859 in view of Beijani '042. In view of the fact that claims 21, 23, 30 and 32 depend from an allowable claim, Applicants request that the rejection of claims 21, 23, 30 and 32 be withdrawn.

**CONCLUSION**

For the foregoing reasons, Applicant requests the Examiner allow claims 9-32 and advance the application to issuance.

**FEE AUTHORIZATION**

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. **23-2415** (Docket No.: 34655-703.831).

Date: June 10, 2007

WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
Direct Dial: (650) 849-3207  
Customer No.: 21971

Respectfully submitted,

By: 

Cecily Anne O'Regan  
Registration No. 37,448